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Application Number	10/015,551
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First Named Inventor	Keith D. ALLEN
Group Art Unit	1636
Examiner Name	Quang NGUYEN
Total Number of Pages in This Submission	5
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ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kelly L. Quast, Reg. No. 52,141
Signature	
Date	March 27, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **Keith D. ALLEN**

Serial No.: **10/015,551**

Filed: **December 11, 2001**

Title: **Transgenic Mice Containing Brain-Specific Membrane-Anchored Protein Gene Disruptions**

Group Art Unit: **1636** *47*

Examiner: **Nguyen, Quang**

Customer No. **26619**

Docket/Order No. **R-227**

Date: **March 27, 2003**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed February 26, 2003, concerning the Examiner's restriction to the claims, Applicant hereby provisionally elects, with traverse, Invention II (claims 1-12, 15, 17-26 and 30), drawn to a targeting construct for a brain-specific membrane-anchored protein (BSMAP), a method of producing the targeting construct, a non-human transgenic animal or mouse comprising a disruption in a BSMAP gene, an isolated cell derived from the same transgenic animal or mouse, methods of producing the same transgenic mouse, and methods for identifying an agent that modulates the expression or the function of a BSMAP gene using the same transgenic animal or mouse or cells derived from the same.

In the restriction, the Examiner asserts that claims 1-32 are drawn to five distinct subjects, grouped as: Invention Group I (claims 1-7, 13-14 and 27-28), drawn to a targeting construct for a brain-specific membrane-anchored protein (BSMAP), method of producing the targeting construct, and isolated cell comprising a disruption in a BSMAP gene and methods of identifying an agent that modulates the expression or the function of a BSMAP gene using the same cell; Invention Group II (claims 1-12, 15, 17-26 and 30), drawn to a targeting construct for a brain-specific membrane-anchored protein (BSMAP), a method of producing the targeting construct, a non-human transgenic animal or mouse comprising a disruption in a BSMAP gene, an isolated cell derived from the same transgenic animal or mouse, methods of producing the same transgenic mouse, and methods for identifying an agent that modulates the expression or the function of a BSMAP gene using the same

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transgenic animal or mouse or cells derived from the same; Invention Group III (claims 16 and 29), drawn to an agent identified by the methods of the presently claimed invention; Invention Group IV (claim 31), drawn to an agonist or antagonist of a BSMAP; and Invention Group V (claim 32), drawn to phenotypic data associated with the transgenic mouse of the presently claimed invention wherein the data is in a database. Applicant respectfully traverses the requirement for restriction and requests reconsideration and withdrawal of the requirement.

As stated in MPEP §803, the requirements for a proper claim restriction are as follows: “(a) the inventions must be independent or distinct as claimed; and (b) there must be a serious burden on the examiner if restriction is required.”

A proper claim restriction must place a “serious burden” on the Examiner if the claims were examined without a restriction. In order to establish a serious burden, the Examiner must “show by appropriate explanation one of the following: separate classification thereof, a separate status in the art, or a different field of search.” This showing of a serious burden is required even if the claimed inventions have been shown to be distinct. See MPEP §808.02

The instant Office Action generally asserts that restriction is warranted between Invention Groups I through V in that the claimed inventions are chemically, physically and structurally distinct. The Examiner has further based the restriction of claims on, for example, alleged differences in starting materials, method steps and technical considerations of claimed methods. However, the Applicant submits that the Examiner has not established that a serious burden would result from a search of the invention groups together. The Applicant does not believe that the Examiner has fulfilled the requirements for a proper claim restriction based on a serious burden standard.

Specifically, the Examiner asserts that the cell comprising a disruption in a BSMAP gene of Group I, the non-human transgenic animal or mouse comprising a disruption in a BSMAP gene of Group II, the agent identified of Group III, the agonist and antagonist of a BSMAP of Group IV and the phenotypic data in a database of Group V are chemically, physically and structurally distinct one from the others. The Examiner further concludes that the cell of Group I can be made by means other than the transgenic non-human animal or mouse of Group II. The Examiner also asserts that the methods in Group I differ from those of Group II because they involve different starting materials, different method steps and different technical considerations for attaining different desired results. The Applicant respectfully disagrees with the Examiner’s conclusions. The Applicant submits that the subject matter of each of these Invention Groups is related. A reasonable

search of the prior art on an aspect of the subject matter of the claims of any one of the Invention Groups, e.g. disruptions in a brain-specific membrane-anchored protein gene in a mouse, would reveal results that would encompass the subject matter of each group. Thus, a serious burden to the Examiner would not result as a separate search or examination would not be required.

Although the Applicant has provisionally elected Invention II for the purposes of advancing prosecution of the present application, the Applicant contends for the foregoing reasons that the requirement for restriction between Inventions I through V is improper. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the requirement.

Respectfully submitted,

Date: 3/27/03

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I hereby certify that this correspondence and its listed enclosures is being deposited with the United States Postal Service as First Class Mail, postage paid, in an envelope addressed to:
Commissioner for Patents, Washington, D.C. 20231 on March 27, 2003

Name: **Deborah A. Mojarrro**

Signed: *Deborah A. Mojarrro*

Date: 3/27/03